

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SONIA REGINA TUCCORI

Appeal No. 2003-0944
Application No. 09/577,955

ON BRIEF

Before WILLIAM F. SMITH, SCHEINER and MILLS, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 8-14 and 16. Claim 15 stands objected to as dependent on a rejected base claim, but according to the examiner (Answer, page 2), is otherwise allowable.

Claims 8 and 16 are representative:

8. A method for topically treating hair which comprises contacting said hair with a combination of:

(i) an amino acid, a salt of an amino acid, or a hydrosalt of an amino acid, wherein said amino acid, salt of an amino acid or hydrosalt of an amino acid has an aliphatic side chain; and

(ii) an amino acid, a salt of an amino acid or a hydrosalt of an amino acid, wherein said amino acid, salt of an amino acid, or hydrosalt of an amino acid has a basic side chain.

16. A method according to claim 8, wherein (i) is isoleucine and (ii) is lysine.

The reference relied on by the examiner is:

Carr et al. (Carr)

WO 98/18432

May 7, 1998

Claims 8 through 14 and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over Carr.

We affirm the examiner's rejection of the claims.

DISCUSSION

Initially we note appellant's statement on page 11 of the Brief that "[i]ndependent claim 8, and dependent claims 9, 10, 11, 12, 13 and 14 stand or fall by themselves[.]" as opposed to "[d]ependent claim 16 [which] stands or falls by itself." Inasmuch as no argument has been made for the separate patentability of claims 8-14, we understand appellant's position to be that claims 8 through 14 stand or fall together, but separately from claim 16. Therefore, we shall limit our consideration of the issues raised by this appeal as they pertain to claims 8 and 16. See 37 CFR § 1.192(c)(7) (1999).

Claim 8 is directed to a "method for topically treating hair" comprising contacting the hair with a combination of (i) an amino acid with an aliphatic side chain, and (ii) an amino acid with a basic side chain. Claim 16 depends from claim 8 and specifies that (i) is isoleucine and (ii) is lysine.

Carr describes methods and hair treatment compositions for "modify[ing] or nourish[ing] the hair or hair root," wherein the "hair treatment compositions . . . contain amino acid actives" (page 1). "Particularly preferred" amino acids are "cysteine, arginine, serine, glutamic acid, glutamine, isoleucine, lysine, methionine and valine," and "[m]ixtures of the amino acids . . . may also be used" in the hair treatment compositions (pages 4 and 5).

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992). The examiner acknowledges that Carr does not describe “combinations of isoleucine and lysine[] in a specific example” (Answer, page 4), but concludes that “it would have been obvious to one of ordinary skill in the art to use isoleucine or lysine or combinations thereof in a shampoo or conditioner because the reference teaches these amino acids to be preferred embodiments, included in a list of only nine amino acids” (id.). Appellant, on the other hand, argues that “the present invention is [one] of selection,” and “it would not have been obvious to one of ordinary skill in the art to arrive at compositions having the recited amino acids merely because there is contained within [Carr] a list of only nine amino acids” (Brief, page 12).

We cannot subscribe to appellant’s position. Certainly it has been held that “[a] disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds[.]” In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1150, 1552 (Fed. Cir. 1994), but that is not the situation here. The number of possible combinations of the nine amino acids preferred by Carr is not particularly large, nor is there anything in the reference to indicate a preference leading away from a combination of isoleucine and lysine. The mere fact that Carr discloses a genus of hair treatment compositions (which undeniably embraces the hair treatment composition required by the claims) without particularly specifying the required composition, does not make any one of the compositions less obvious than any other, especially here, where the possibilities are relatively limited. See Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989), wherein it was held that disclosure of “a multitude of effective combinations” (approximately 1200) “does not render any particular combination less obvious . . . especially . . . [where] the claimed composition

is used for the identical purpose taught by the prior art.”

Nor are we persuaded by appellant’s argument that “there is no motivation [in the prior art] to make this combination for the purpose of preventing or repairing split ends” (Brief, page 13). Prima facie obviousness does not require that the prior art references suggest combining their disclosures for the same reason that appellants combined them. In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc) (“it is not necessary in order to establish a prima facie case of obviousness . . . that there be a suggestion in or expectation from the prior art that the claimed compound or composition will have the same or a similar utility as one newly discovered by applicant).”

On the record before us, we find no error in the examiner’s determination that Carr’s teachings are sufficient to establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103 as to the subject matter of claim 16, which requires the combination of isoleucine and lysine. As to the subject matter of claim 8, appellant argues that “[t]here is no suggestion . . . to select one amino acid with an aliphatic side chain and one amino acid with a basic side chain” (Brief, page 12). Nevertheless, claim 16 necessarily requires a combination of an amino acid with an aliphatic side chain (isoleucine) and an amino acid with a basic side chain (lysine), thus, it follows that Carr’s teachings are sufficient to establish a prima facie case of obviousness as to the subject matter of claim 8 as well. As discussed above, claims 9-14 stand or fall with claim 8.

Accordingly, the examiner’s rejection of claims 8 through 14 and 16 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

William F. Smith
Administrative Patent Judge

Toni R. Scheiner
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

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Appeal No. 2003-0944
Application No. 09/577,955

Page 6

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